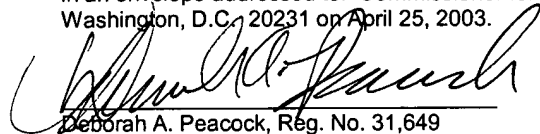


Part of 26

Ser. No. 09/607,313

Filed in Triplicate  
**PATENT APPLICATION**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231 on April 25, 2003.



Deborah A. Peacock, Reg. No. 31,649

RECEIVED  
MAY - 1 2003  
TC 1700 MAIL ROOM

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant/Appellant: Brad Baker

Examiner: L. Tran

Serial No.: 09/607,313

Group Art Unit: 1761

Filed: June 28, 2000

For: PAINT SET  
CONFECTIONARY

Commissioner for Patents  
Washington, D.C. 20231  
ATTN: Board of Patent Appeals and Interferences

RECEIVED  
2003 SEP 30 11:19:19  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

**APPLICANTS REPLY BRIEF**

The Examiner's Answer advances no reasons in support of the rejection of Claim 29 not earlier set forth, fails to respond to numerous arguments of applicant, and distorts the record.

At page 2, the Examiner argues that the specification does not disclose a separate paint brush holder attached to the container. As in the Final Rejection (Paper No. 22) the Examiner once more misquotes the specification -- "the brush and can are connectable through packaging such as shrink-wrap, adhesive or other packaging." -- In Applicant's Brief for Appellant ("Brief"), it was pointed out that this was a truncated quote, set forth in full in the Brief at page 3. Yet the Examiner persists in this distortion of the record (Answer, page 4). The remainder of the sentence clearly modifies the term "other packaging"

continuing as follows: “as shown in Fig. 14(c) which comprises a finite length cylinder **80** connected to a finite length hollow tube section having a substantially rectangle cross-section **82**”. In Claim 27 submitted in a Preliminary Amendment there is a “brush holder” recited. Even without that specific word description, Fig. 14 shows the brush, in the front and side views, inserted in the hollow tube section of substantially rectangular cross-section. The Examiner dismisses the truncated sentence as if it was not misleading and argues: “It is nowhere disclosed that cylinder **80** or hollow tube **82** is the paint brush holder.” Fig. 14(c) in the written description is described as a top view of a “brush and paint can assembly piece of the present invention.” (Emphasis added) Ignoring the emphasized words, the Examiner states (Answer, page 4 near bottom) that the top view “of the paint can and the brush and not a paintbrush holder attached to the container.” That statement is incredulous. Fig 14 does not show a can at all and shows the brush only in the elevation views. How could tube section **82** be a brush? What does “assembly piece” mean, if **82** is a brush and cylinder **80** is a can? The Examiner then states that in Fig. 14(c) “... element **82** is the top view of the brush.” (Answer, page 5) Yet reference numeral **10** for the brush is not used in Fig. 14(c), and a top view of the brush handle would show the tip and the change in width. The Fig. 14(c) assembly piece **78** (comprising finite length cylinder **80** and the hollow tube section **82**) is called “packaging **78**” (Specification, page 11) that “cooperatively receives can **18** and brush **10**.” The Examiner’s argument is plainly and simply, wrong. Finally, the Examiner’s current position is inconsistent with the Examiner’s statement in the early Office Action of May 8, 2001: “It would also have been obvious to include a lid ... and to include a holder as a variation ...” (Page 4). Apparently, the Examiner did recognize that the disclosure included a brush holder at an earlier time and has now shifted her position.

The correct interpretation of the disclosure is dispositive of this appeal. If there is a “brush holder” type of packaging—which is emphatically the case—there is no corresponding element in the Examiner’s combination of prior art references. The Examiner argues (Answer, page 8, near bottom) that the cellophane package in the primary prior art reference “attaches” the roller to the tray, but that is not a “brush holder” as clearly recited in the claim. On this ground alone, the Examiner should be reversed and Claim 29 allowed.

At page 5, the Examiner states that she cannot grasp applicant’s argument because applicant cites only portions of the Examiner’s arguments. The Examiner’s failure to understand arguments is perhaps one reason why the Examiner throughout prosecution has only repeated earlier rejections in enigmatic mantras. Applicant has difficulty with a rejection that repeatedly states that it is obvious to “move” from one conventional shape to another conventional shape. What is meant by “move”? Is invention determined by movement? Is this a new Section 103 test?

This strange expression of a Section 103 rejection stems from the fact that the Examiner has not found a paint brush, a can or a holder in the novelty candy art. Since these three elements were not found, the Examiner conjured an argument based on the fact that both products simulate painting tools. (Office Action dated August 2, 2002, page 3: "Applicant's argument would have been persuasive if there is no teaching of any lollipop product which simulates actual paint product; ...") That is also not a proper rejection. But, in fact, the only similarity in the claimed subject matter and the Paint Pop product is that both are derived from real paint products. Applicant has set forth again and again the difference in function of the claimed elements vis-à-vis the prior art, but the Examiner simply denies, or fails to understand, these functional differences. Moreover, the Examiner in the move-from-conventional-shape argument points to lollipops with different shapes. The invention is not merely a paint brush shaped sucker versus a paint roller shaped sucker. The claim is drawn to a kit comprising a sucker, a container, flowable confectionery, a lid and a brush holder. Only the confectionery is common to the Paint Pop and claimed invention. The other elements are entirely different in form and function. There is neither logic nor legal authority for the Examiner's "move" argument. It must be rejected.

At page 6, the Examiner addresses the lid element and states that although the prior art product, considered with the lid in the secondary references, does not need a lid to contain the confectionery (because it is contained in a separate packet) "does not mean that the lid is not beneficial to the product or that a lid cannot be added." This too is some new Section 103 test: If an element missing in a primary reference can benefit from a secondary reference element, or at least "if" it is possible to add it, then the two can be combined to meet the claimed product. Where is the suggestion that the law clearly requires as a guard against hindsight? Here, the added lid is not necessary. Why should it be combined if there is no need? Moreover, the Examiner never explains the unnecessary benefit.

Applicant has pointed out two reasons for a lid: to enclose the confectionery during interrupted consumption, and at the time of sale. The latter is a limitation of the claim. The prior art combination does not teach that the confectionery can be contained by a lid, it teaches containing the confectionery in a packet. It does not teach any benefit from enclosing the confectionery in a packet and then double enclosing by placing the packet in a tray with a lid. Nor does the secondary reference, a real paint tray and cover, teach the sale of paint in the paint tray, with or without a packet. The Examiner is engaging in hindsight, and even then, cannot meet all of the claim limitations.

Also at page 6, the Examiner argues that there are “many known reasons” why it was obvious and “many reasons which would motivate one skilled in the art to include a lid ...” However, without any disclosure of these reasons why it was not obvious, the principle one being that it was never done, and there are many reasons not to add a lid at the time of sale, the principle one being that it was redundant.

At the bottom of page 6 the Examiner argues that the claim does not “require that the lid contain the flowable confectionery.” But the claim recites that the flowable confectionery is “disposed within the lid-enclosed container at the time of sale.” How could this language be more clear? Is the Examiner saying that the claim does not require that the “lid” vis-à-vis the container with lid contain the confectionery? That may be true but has nothing to do with the argument.

At page 7 the Examiner takes issue with applicant's statement that if two products contain many components, and one product has one less component, it is cheaper. The Examiner is nit-picking. Applicant should have stated: “...all other things being equal.” Explicitly stating this condition does not detract from the cost argument at all.

The Examiner responds (bottom of page 7) to the statement of applicant that the Paint Pop tray material is too thin to support a lid that would seal the tray. The Examiner responds by again redesigning the primary prior art reference by increasing the thickness of the material, asking rhetorically, why else would one want to put a lid on the tray. The answer is that no one but the Examiner does want to put on a lid, certainly not the designer of the Paint Pop product, who was satisfied with a packet to contain the confectionery.

At page 8, the Examiner criticizes applicant's argument that the claim does not include a packet. The Examiner states that the fact that a “claim does not positively recite an element does not mean that the element is excluded.” If the Examiner is stating that a claim with four elements cannot be distinguished from a prior art reference with five elements, except by stating: “not including element five,” that would be a new rule of claim construction or one applicant has overlooked and for which some legal authority would have been appreciated.

At page 8, the Examiner attempts to rebut applicant's argument that the structural differences between the prior art and the claim have different functions as well. The Examiner's response that “differences in structure ... reside in the shape” is tautological. And has nothing to do with applicant's point.

Finally, the Examiner has addressed the declarations in support of non-obviousness by pretending she is an expert in novelty candy design. Applicant qualified all of the declarants as experts with strong foundations to permit them to express opinions. The Examiner simply argues that the opinions are wrong, as if she too had expert qualifications. Or she dismisses opinions on the ground that a survey is required. Applicant offered sales figures to support the argument of commercial success. The Examiner stated that the figures had to be benchmarked. Applicant offered as reference points prior products of applicant's assignee, competitor products, sales growth over time, and industry-wide sales comparisons for novelty products. The Examiner then stated that applicant must prove that the sales growth emanates "solely" from the inventive features. That is not the law.

**SUMMARY**

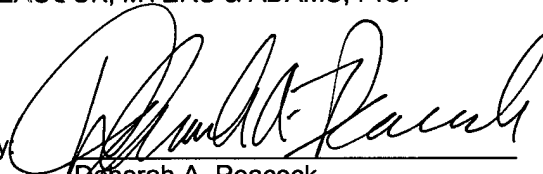
It is respectfully requested that the position of the Examiner be reversed and Claim 29 found allowable.

Respectfully submitted,

PEACOCK, MYERS & ADAMS, P.C.

Dated: April 25, 2003

By:



Deborah A. Peacock  
Reg. No. 31,649  
Direct Dial: (505) 998-1501

P.O. Box 26927  
Albuquerque, New Mexico 87125-6927

Telephone: (505) 998-1500  
Facsimile: (505) 243-2542

**Customer No. 30687-1001**

RECEIVED  
MAY - 1 2003  
TC 1700 MAIL ROOM

Ser. No. 09/607,313

G:\Sarah\Impact Confections Brief.doc